



S/N 09/111978

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Leonard H. Bieman

Examiner: Hoa Pham

Serial No.: 09/111978

Group Art Unit: 2877

Filed: July 8, 1998

Docket: 139.045USR

Title: SCANNING PHASE MEASURING METHOD AND SYSTEM FOR AN
OBJECT AT A VISION STATION

PATENT

#26 Brief
Oral Hear.
T. L. W.
10.16.03

**APPELLANT'S BRIEF IN REPLY TO EXAMINER'S ANSWER
AND REQUEST FOR ORAL HEARING**

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Commissioner for Patents

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This Appellant's Reply Brief is presented in response to the Examiner's Answer Appellant's Brief on Appeal, mailed July 31, 2003. Appellant's Brief on Appeal was brought regarding the final rejection of claims 30-85 of the above-identified application, as set forth in the final Office Action mailed June 22, 2001.

The Appellant's Reply Brief is filed in triplicate. Please charge any required additional fees or credit overpayment to Deposit Account 19-0743.

REQUEST FOR ORAL HEARING

In accordance with 37 C.F.R. § 1.194, Appellant hereby requests an oral hearing to present his appeal to the Board of Patent Appeals and Interferences. Please charge the fee of \$140.00 for oral hearing request to Deposit Account 19-0743.

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ARGUMENT

As noted in M.P.E.P. 1412.02 *Recapture of Canceled Subject Matter*,

A reissue will not be granted to "recapture" claimed subject matter deliberately canceled in an application to obtain a patent. *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 U.S.P.Q. 289, 295 (Fed. Cir. 1989); *In re Wadlinger*, 496 F.2d 1200, 181 U.S.P.Q. 826 (C.C.P.A. 1974); *In re Richman*, 409 F.2d 269, 276, 161 U.S.P.Q. 359,

363-64 (C.C.P.A. 1969); *In re Willingham*, 282 F.2d 353, 127 U.S.P.Q. 211

(C.C.P.A. 1960). The Federal Circuit stated the following principles in *Clement*:

(1) if the reissue claim is as broad as or broader than the canceled or amended claim in all aspects, the recapture rule bars the claim; (2) if it is narrower in all aspects, the recapture rule does not apply, but other rejections are possible; (3) **if the reissue claim is broader in some aspects, but narrower in others, then:** (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; (b) **if the reissue claim is narrower in an aspect germane to a prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.**

[*In re Clement*,] 131 F.3d at 1469-70, 45 USPQ2d at 1165. See M.P.E.P. Section 1412.03 as to broadening claims.

Impermissible recapture occurs in a reissue where the claims in the reissue are of the same scope as, or are broader in scope than, claims deliberately canceled in an application to obtain a patent. **Where such claims also include some narrowing limitation not present in the claims deliberately canceled in the application, the examiner must determine whether that narrowing limitation has a material aspect to it. If the narrowing limitation has a material aspect to it, then there is no recapture.** However, if the narrowing limitation is incidental, mere verbiage, or would be inherent even if not recited (in view of the specification), then the claims should be rejected under 35 U.S.C. 251 using form paragraph 14.17.

(Bold emphasis added.)

As noted in *Hester Industries Inc. v. Stein, Inc.*, 46 USPQ2d 1641, 1649-50 (Fed Cir 1998) col. 2:

Finally, because the recapture rule may be avoided in some circumstances, we consider whether the reissue claims were materially narrowed in other respects. See, e.g., *Mentor*, 998 F.2d at 996, 27 U.S.P.Q.2D (BNA) at 1525 (" Reissue claims that are broader in certain respects and narrower in others may avoid the effect of the recapture rule."); *Clement*, 131 F.3d at 1470, 45 U.S.P.Q.2D (BNA) at 1165. For example, **in Ball the recapture rule was avoided because the reissue claims were sufficiently**

narrowed (described by the court as "fundamental narrowness") despite the broadened aspects of the claims. 729 F.2d at 1438, 221 U.S.P.Q. (BNA) at 296. In the context of a surrender by way of argument, this principle, in appropriate cases, may operate to overcome the recapture rule when the reissue claims are materially narrower in other overlooked aspects of the invention. The purpose of this exception to the recapture rule is to allow the patentee to obtain through reissue a scope of protection to which he is rightfully entitled for such overlooked aspects.
(*Bold emphasis added.*)

Discussion of the present case

Applicant has broadened the claims by not including the limitation "at a substantially constant velocity." As noted in M.P.E.P. 1412.02 (3) (b) if the reissue claim is narrower in an aspect germane to a prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible. *In re Clement*, 131 F.3d at 1469-70, 45 USPQ2d at 1165.

The narrowing aspects of the present claim that is germane to the original rejection are "maintaining the projected pattern of light and the detector in a substantially fixed relation to each other" "moving the object relative to the projected pattern of light", which clearly distinguishes the invention claimed in claims 30-85 from the cited references. It is clear that this is a material narrowing that is directly pertinent to the subject matter surrendered during prosecution, in distinction to the situation in *Pannu v. Storz Instruments*, 59 USPQ2d 1597 (Fed Cir 2001). During prosecution, Pannu narrowed the claim "defining a continuous, substantially circular arc having a diameter greater than the diameter of the lens body," had made extensive arguments that the prior art had no such particular shape, and taught away from a circular arc, etc. Thus the recapture by removing the shape limitation in Pannu was held to be impermissible, because the narrowing aspect of the new claims was not related to the shape, but rather the positioning and dimensions of the snag-resistant means.

As discussed above, *In re Clement*, 45 USPQ2d at 1165 states "(b) if the reissue claim is narrower in an aspect germane to a prior art *rejection*, and broader in an aspect unrelated to the *rejection*, the recapture rule does not bar the claim, but other rejections are possible." It is not whether the claim is narrower in an aspect related to the limitation added in the original prosecution, but rather whether the narrowing aspects are germane to the original *rejection*.

In the present case, the claims were narrowed in the original prosecution by adding a limitation to movement, a limitation to the fixed relationship, and a limitation to the detector elements. The new limitations in the reissue claims presented here are germane to the rejection. U.S. Patent 4,212,073 to Balasubramanian, for example, did not move the detector relative to the object, but rather kept the object and detector in a fixed relationship and moved the projector transparency (and thus the projected pattern of light). The aspect of the present claim that is unrelated to the rejection are the limitations insisted to by the Examiner "at a substantially constant velocity" and "which are substantially uniformly spaced" and [projector and detector in a] "substantially fixed relationship to one another" since those limitations do not further distinguish the claims from the prior art, and thus are not pertinent to the original rejection. It is the moving of the detector relative to the object, the light pattern whose relationship remains fixed to the detector elements in the present claimed invention (not so in the prior art, in which the pattern of light moves, even if the projector does not) that are germane to the rejection and to the surrendered subject matter.

Because the reissue claims 30, 42, 56, 60 and 72 are narrower in an aspect germane to a prior art rejection, and broader in an aspect not germane to the rejection, the recapture rule does not bar the claims, and reversal of the rejection is respectfully requested.

The Examiner's Answer to Appellant's Brief on Appeal, mailed July 31, 2003, provided no response to the Applicant's arguments relative to the obviousness rejections under 35 U.S.C. 103. Applicant's previous arguments thus stand as they are.

Applicant has provided arguments for all the independent claims. Since each claim provides a different combination which must be considered as a whole, each stands alone for this Appeal. The dependent claims stand alone, as each adds further limitations, and thus provides a different combination than the other claims, and must be considered as a whole.

The claims are as stated in the previous Appeal Brief filed March 10, 2003.

CONCLUSION

Appellant believes the claims are in condition for allowance and requests reconsideration and reversal of the rejections to claims 30-85. Reversal of the Examiner's rejections of claims 30-85 in this appeal is respectfully requested.

Respectfully submitted,

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Name

Charles A. Lemaire
Signature



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Leonard H. Bieman

SCANNING PHASE MEASURING METHOD AND SYSTEM FOR AN OBJECT AT A VISION STATION

Docket No.: 139.045USR
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Examiner: Hoa Pham
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We are transmitting herewith the following attached items (as indicated with an "X"):

- ☒ A return postcard.
- ☒ Appellant's Brief in Reply to Examiner's Answer And Request For Oral Hearing (5 pgs; IN TRIPLICATE), with authorization to charge fees to Deposit Acct. 19-0743.

If not provided in a separate paper filed herewith, Please consider this a PETITION FOR EXTENSION OF TIME for sufficient number of months to enter these papers and please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

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By: Charles A. Lemaire
Atty: Charles A. Lemaire
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